

Remarks/Arguments

Claims 1-12 and 46-47 were pending in the application. Claims 1-12 and 46-47 were rejected. No claims were merely objected to and no claims were allowed. By the foregoing amendment, no claims are canceled, no claims are amended, and no new claims are added. No new matter is presented.

Double Patenting

Generally, the examiner asserts claims 1-12 and 46-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 3, 5, 9, 10, 11 of copending U.S.P.N. 7,167,788 ('788). Applicant respectfully traverses the rejection.

Section 804 of the Manual of Patent Examining Procedure (8th ed., August 2001, Latest Revision August 2006) states the following:

“When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992). This does not mean that one is precluded from all use of the patent disclosure.

The specification can be used as a dictionary to learn the meaning of a term in the patent claim. *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999) (“[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning.”); *Renishaw PLC v. Marposs Societa* per Azioni, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) (“Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings.”). See also MPEP § 2111.01. Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970).

The court in *Vogel* recognized “that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim,” but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim. According to the court, one must first “determine how much of the patent disclosure pertains to the invention claimed in the patent” because only

"[t]his portion of the specification supports the patent claims and may be considered." The court pointed out that "this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103, since only the disclosure of the invention claimed in the patent may be examined.

...

Similarly, where, through no fault of the applicant, the claims in a later filed application issue first, an obvious-type double patenting rejection is improper, in the absence of a two-way obviousness determination, because the applicant does not have complete control over the rate of progress of a patent application through the Office. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). While acknowledging that allowance of the claims in the earlier filed application would result in the timewise extension of an invention claimed in the patent, the court was of the view that the extension was justified under the circumstances in this case, indicating that a double patenting rejection would be proper only if the claimed inventions were obvious over each other - a two-way obviousness determination."

The examiner asserts the subject matters of claim 1 of '788 reads on claim 1 of the present application. Upon reviewing claim 1 of '788, Applicants note the claim recites both the terms "an electronic controller" and "a dual-architecture card". Claim 1 further recites the term "dual-architecture card" includes "an open architecture section and a closed architecture section". Dependent claim 6 recites the term "the closed architecture section includes a microserver". Dependent claim 7 recites the term "the open architecture section includes a smart signal conditioner". Applicants draw the examiner's attention to the fact that the "electronic controller" of claim 1 of '788, and all of the dependent claims, do not recite the "electronic controller" includes a microserver. Moreover, the "dual-architecture card" of claim 1 of '788 is the only component described as including "a microserver". In contrast, when reviewing Applicants' specification as-filed and claim 1, neither the specification as-filed nor claim 1 recite or even mention a "dual-architecture card" or a "smart signal conditioner". In addition, the term "electronic controller" of claim 1 recites the term "having a microserver"; however, as one of ordinary skill in the art recognizes from reading claim 1 of '788, a microserver is not a "smart signal conditioner" and does not contain a "smart signal conditioner" as a component. The term "electronic controller" of Applicants' claim 1 is not equivalent to or an obvious variation of the

term “dual-architecture card” of claim 1 of `788. Moreover, the term “electronic controller” of Applicants’ claim 1 is not equivalent to or an obvious variation of the term “electronic controller” of `788 as the term “electronic controller” of claim 1 of `788, and all the dependent claims, does not include a microserver. Applicants contend claim 1 of `788 cannot read on or constitute obvious variants of all the claim terms of Applicants’ claim 1 given the meanings of the `788 terms “electronic controller”, “dual-architecture card” and “smart signal conditioner” are entirely different when reading claim 1 of `788 in light of all its claims and the specification.

The examiner also asserts the following: the subject matters of claim 1 of `788 reads on claim 2 of the present application; the subject matters of claim 2 of `788 reads on claim 3 of the present application; the subject matters of claim 3 of `788 reads on claim 4 of the present application; the subject matters of claim 5 of `788 reads on claim 5 of the present application; the subject matters of claim 5 of `788 reads on claims 6-9 of the present application; the subject matters of claim 9 of `788 reads on claim 10 of the present application; the subject matters of claim 10 of `788 reads on claim 11 of the present application; and, the subject matters of claim 11 of `788 reads on claim 12 of the present application. Applicants reiterate the remarks with respect to the interpretation of claim 1 of `788 in view of claim 1 of the present application. Applicants contend the claims 1, 2, 3, 5, 9 and 10 of `788 cannot be read upon the terms of claims 2-12 for the aforementioned reasons set forth above.

The examiner asserts the subject matters of claim 1 of `788 reads on claim 46-47 of the present application. Upon reviewing claim 1 of `788, Applicants again reiterate the claim recites both the terms “an electronic controller” and “a dual-architecture card”, and the term “dual-architecture card” includes “an open architecture section and a closed architecture section”. Dependent claim 6 recites the term “the closed architecture section includes a microserver”. Dependent claim 7 recites the term “the open architecture section includes a smart signal conditioner”. Applicants draw the examiner’s attention to the fact that the “electronic controller” of claim 1 of `788, and all of the dependent claims, do not recite the “electronic controller” includes a microserver. Moreover, the “dual-architecture card” of claim 1 of `788 is the only component described as including “a microserver”. In contrast, when reviewing Applicants’ specification as-filed and claims 46-47, neither the specification as-filed nor claims 46-47 recite or even mention a “dual-architecture card” or a “smart signal conditioner”. As one

of ordinary skill in the art recognizes from reading claim 1 of `788, a microserver is not a “smart signal conditioner” and does not contain a “smart signal conditioner” as a component. The claimed electronic controller of Applicants’ claim 46 is not equivalent to or an obvious variation of the term “dual-architecture card” of claim 1 of `788. Moreover, the claimed electronic controller of Applicants’ claim 46 is not equivalent to or an obvious variation of the term “electronic controller” of `788 as the term “electronic controller” of claim 1 of `788, and all the dependent claims, does not include a microserver. Applicants contend claim 1 of `788 cannot read on or constitute obvious variants of all the claim terms of Applicants’ claim 46 given the meanings of the `788 terms “electronic controller”, “dual-architecture card” and “smart signal conditioner” are entirely different when reading claim 1 of `788 in light of all its claims and the specification.

In the alternative and/or in addition to the above-mentioned remarks, Applicants contend the claims of the pending application at issue was filed earlier than the `788 patent and thus the obviousness-type double patenting rejections should be withdrawn. Applicants contend that but for administrative delays on the part of the United States Patent Office, the present application would have been examined prior to the issuance of the `788 patent. Upon reviewing the examination history, the examiner can confirm the Applicants are not responsible for the delay in the prosecution of the present earlier filed application. For instance, Applicants have not filed any responses requiring an extension of time in this matter. In addition, Applicant could not have filed the allegedly conflicting claims of the present application in an earlier filed application. Applicants have already established the fact that the claimed invention of `788 is different than the subject matter of Applicants’ claims 1-12 and 46-47. Given the notable differences between the claimed subject matter of `788 and the present application, the claims of the `788 patent did not belong in the pending claims of the present application. For at least these reasons, Applicants contend the present obviousness-type double patenting rejections should be withdrawn. In light of the foregoing, Applicants respectfully request the examiner withdraw the pending obviousness-type double patenting rejections and find that claims 1-12 and 46-47 are allowable.

CONCLUSION

In light of the foregoing, it is submitted that all of the claims as pending patentably define over the art of record and an early indication of same is respectfully requested.

An earnest and thorough attempt has been made by the undersigned to resolve the outstanding issues in this case and place same in condition for allowance. If the Examiner has any questions or feels that a telephone or personal interview would be helpful in resolving any outstanding issues which remain in this application after consideration of this amendment, the Examiner is courteously invited to telephone the undersigned and the same would be gratefully appreciated.

It is submitted that the claims as amended herein patentably define over the art relied on by the Examiner and early allowance of same is courteously solicited.

If any fees are required in connection with this case, it is respectfully requested that they be charged to Deposit Account No. 21-0179.

Respectfully submitted,

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